



DAK #16

PATENT
Attorney Docket No. 3495.0111-11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bernard DUJON et al.

Serial Number: 09/492,697

Filed: January 27, 2000

Group Art Unit: 1633

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING
THE ENZYME I-SCEI AND THE USES THEREOF

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

PETITION UNDER 37 C.F.R. § 1.144 and 37 C.F.R. § 1.181

Pursuant to 37 C.F.R. § 1.144 and 37 C.F.R. § 1.181, applicants hereby

respectfully petition the Assistant Commissioner to review the restriction requirement made by the Examiner in the Office Action dated February 12, 2001 (Paper No. 11), and to have the claims of Groups I-IV (pending claims 45-60; Exhibit 1) considered on the merits. Specifically, applicants respectfully request that the Examiner's objection to and withdrawal from consideration of claims 45-48, 50-55, and 57-60 in the Office Action dated June 20, 2001 (Paper No. 14), be withdrawn.

Applicants respectfully request relief in the form of allowing applicants to have pending claims 45-60 (Exhibit 1) in the above referenced application fully considered on the merits.

Applicants submit that the restriction requirement made by the Examiner in the Office Action dated February 12, 2001, is in error and that the resultant objection to and

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withdrawal from consideration of pending claims 45-48, 50-55, and 57-60 as being drawn to non-elected inventions in the Office Action dated June 20, 2001, is in error.

In the Office Action dated February 12, 2001, the Examiner required restriction to the claims of one of the following Groups:

Group I - Claims 23-37, drawn to a recombinant mammalian chromosome and cells comprising a group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 325.

Group II - Claims 23-34, 36, and 37, drawn to a recombinant mammalian chromosome and cells comprising a group I intron encoded endonuclease site (**I-SceIV**), classified in class 435, subclass 325.

Group III - Claims 23-34, 36, and 37, drawn to a recombinant mammalian chromosome and cells comprising a group I intron encoded endonuclease site (**I-Csml**), classified in class 435, subclass 325.

Group IV - Claims 23-34, 36, and 37, drawn to a recombinant mammalian chromosome and cells comprising a group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 325.

Group V - Claims 23-37, drawn to a recombinant plant chromosome and cells comprising a group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 410.

Group VI - Claims 23-34, 36, and 37, drawn to a recombinant plant chromosome and cells comprising a group I intron encoded endonuclease site

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(**I-SceIV**), classified in class 435, subclass 410.

Group VII - Claims 23-34, 36, and 37, drawn to a recombinant plant chromosome and cells comprising a group I intron encoded endonuclease site (**I-Csml**), classified in class 435, subclass 410.

Group VIII - Claims 23-34, 36, and 37, drawn to a recombinant plant chromosome and cells comprising a group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 410.

Group IX - Claims 38-43, drawn to a recombinant retroviral vector comprising a HO and group I intron encoded endonuclease site (**I-SceI**), classified in class 435, subclass 320.1.

Group X - Claims 38-42, drawn to a recombinant retroviral vector comprising a HO and group I intron encoded endonuclease site (**I-SceIV**), classified in class 435, subclass 320.1.

Group XI - Claims 38-42, drawn to a recombinant retroviral vector comprising a HO and group I intron encoded endonuclease site (**I-Csml**), classified in class 435, subclass 320.1.

Group XII - Claims 38-42, drawn to a recombinant retroviral vector comprising a HO and group I intron encoded endonuclease site (**I-PanI**), classified in class 435, subclass 320.1.

In the Office Action dated February 12, 2001, the Examiner stated that claims 23-27, 29-34, 36, and 37 were generic to Groups I-VIII because they contain multiple

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inventions, and that these claims would be examined to the extent that they contain elected subject matter if any of Groups I-VIII is elected. (Paper No. 11 at 4.)

Applicants timely traversed this requirement, provisionally electing the claims of Group I for examination. (Response to Paper No. 11.) Applicants also canceled claims 23, 25-30, and 32-37 (claims 24 and 31 having previously been canceled), and added new claims 45-60, which are derived from the canceled claims 23, 25-30, and 32-37. (Response to Paper No. 11 at 1-3.) New claims 45-60 all read on the elected invention.

However, in the Office Action dated June 20, 2001, the Examiner withdrew pending claims 45-48, 50-55, and 57-60 from consideration as being drawn to a non-elected invention. (Paper No. 14 at 3.) The Examiner also objected to the claims because they "encompass non-elected subject matter" (*Id.*) The Examiner appears to be utilizing restriction practice to deny applicants any chance of having generic claims examined. The Examiner has done this by refusing to examine the full scope of applicants' generic claims. This use of restriction practice is improper.

In the February 12, 2001, restriction requirement, the Examiner required applicants to select a single group for examination from among Groups I-XII. Groups I-IV all contain claims 23-34, 36, and 37. Thus, the Examiner placed the claims 23-34, 36, and 37 in four different groups. However, it is the Examiner's position that the elected group of claims will only be examined to the extent that they contain elected subject matter. The Examiner requires applicants to limit the scope of examination to only a single elected species. (Paper No. 11 at 4.) To achieve this goal, the Examiner

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appears to require applicants to amend claims 45-48, 50-55, and 57-60 to overcome this "informality." (Paper No. 14 at 3.) Apparently, the Examiner requires applicants to amend the claims to remove any subject matter beyond a single species. This use of restriction practice is improper.

Essentially, applicants have not been given a choice of groups of claims, but only a choice from among four species, namely, I-Scel, I-ScelV, I-Csml, and I-Panl. The Examiner has chosen four species of applicants' invention and attempted to limit applicants only to one of these species. This restriction practice deprives applicants of any chance to have generic claims examined. This is improper.

Applicants appreciate that an election of species can be required in an application. However, that is not what has occurred in this application. Rather, the Examiner has completely refused to examine any of applicants' genus claims, for example, claim 45, even though they all read on the elected species.

M.P.E.P. § 809 states:

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. See MPEP Section 809.03 for definition of linking claims. . . .

The linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability. Where such withdrawn claims have been canceled by applicant pursuant to the restriction requirement, upon the allowance of the linking claim(s), the examiner must notify applicant that any canceled, nonelected claim(s) which depends from or includes all the limitations of the allowable linking claim may be reinstated by submitting the claim(s) in an amendment. Upon

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entry of the amendment, the amended claim(s) will be fully examined for patentability.

M.P.E.P. § 809.03 further states:

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are

(A) **genus claims linking species claims**

Applicants' claims are genus claims linking species claims. For example, claim 45 recites: "A recombinant mammalian chromosome comprising a Group I intron encoded endonuclease site." This claim recites the genus "Group I intron encoded endonuclease site." The Examiner has recognized that applicants' claims are generic. (Paper No. 11 at 4 stating: "Claims 23-27, 29-34, and 36-37 are generic to Group I-VIII because they encompass multiple inventions.")

Class I I-endonuclease, Class II I-endonuclease, Class III I-endonuclease, Class IV I-endonuclease, Class V I-endonuclease, I-SceI, I-SceIV, I-CsmI, and I-PanI sites, as recited in claims 46-49, are species of Group I intron encoded endonuclease sites. Therefore, claim 45 is a genus claim linking claims 46-49. This linkage requires that claim 45 must be examined with the elected invention.

Furthermore, applicants claimed their invention using claims of varying scope. However, the Examiner's restriction requirement does not allow applicants to claim anything more than one of four species of the invention. Through this restriction practice, the Examiner has refused to examine what applicants regard as their invention. This is improper. M.P.E.P. § 803.02 (stating that: "Since the decisions in *In*

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re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984)").

There has been no allegation or any explanation by the Examiner that the subject matter of claim 45 lacks unity of invention. The invention of claim 45 cannot be considered to lack unity of invention. Applicants' claim 45 recites: "A recombinant mammalian chromosome comprising a Group I intron encoded endonuclease site." Claim 45 encompasses Group I intron encoded endonuclease sites, which are depicted in Fig. 6 of the specification. Group I intron encoded endonucleases can be classified into five classes: Class I I-endonucleases, Class II I-endonucleases, Class III I-endonucleases, Class IV I-endonucleases, and Class V I-endonucleases. (Specification at 27.) These are the classes recited in claims 46 and 53. I-SceI, I-SceIV, I-CsmI, and I-PanI are Class I I-endonucleases. (*Id.* at 47-48.) These are the endonucleases recited in claims 47 and 54. No lack of unity of invention exists. Since there is no lack of unity of invention, applicants respectfully request that claims 45-60 be fully examined.

Furthermore, all of claims 45-60 all read on the elected invention. The Examiner has conceded this point by stating: "genus claim 45 [applicants' sole independent claim] . . . encompasses . . . **I-SceI**" and "[T]he elected species is only limited to a

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recombinant chromosome encoding an I-SceI endonuclease site." (Paper No. 14 at 3.) It cannot be disputed that claim 45 is generic and encompasses the elected species (I-SceI). Claims 46-60 all depend from claim 45, and no claims exclude I-SceI. In addition, dependent claims 48, 49, 55, and 56 specifically recite I-SceI. Consequently, there can be no doubt that claims 45-60 all read on the elected species. Accordingly, applicants respectfully request that claims 45-60 be fully examined.

Furthermore, the Examiner's requirement contravenes 37 C.F.R. § 1.141, which states:

(a) Two or more independent and distinct inventions may not be claimed in one national application, except that **more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided that application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (Section 1.75) or otherwise include all the limitations of the generic claim.**

Applicants' new claims 45-60, derived from canceled claims 23, 25-30, and 32-37, recite more than one species, but do not exceed a reasonable number of species. Claims 45 and 52 are generic to all the claimed species. All claims to species are dependent upon these claims and include all the limitations of the generic claims. Therefore, 37 C.F.R. § 1.141 permits applicants to have all of claims 45-60 examined in this application. Requirement for restriction to a single species is improper. Accordingly, applicants respectfully request that claims 45-60 be fully examined.

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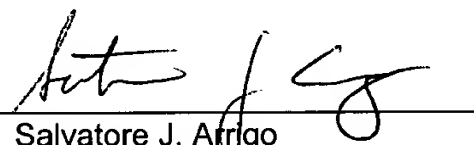
Pursuant to 37 C.F.R. § 1.144 and 37 C.F.R. § 1.181, applicants hereby respectfully request that the Assistant Commissioner reconsider the Examiner's restriction requirement of February 12, 2001, and resultant June 20, 2001, holding of withdrawal of claims 45-48, 50-55, and 57-60 from consideration as being drawn to non-elected inventions.

This Petition is being submitted prior to allowance of the application. An Appeal has not yet been filed in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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